



7297-104

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ki Il Kim

Serial No. 09/708,948

Filed: November 9, 2000

For: CELLULAR PHONE HOLDER WITH
CHARGER MOUNTED TO
VEHICLE DASHBOARD

Group Art Unit: 2682

Examiner: Tran, Tuan A.

I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is being deposited this day, June 14, 2005, with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents and Trademarks, P. O. Box 1450, Alexandria, Virginia 22313-1450.

John D. McConaghy, Reg. No. 26,773

RESPONSE TO RESTRICTION REQUIREMENT

Hon. Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Mandatory Response

Applicant here elects "Species II" consisting of claims 35 through 50. This election is made with traverse and reconsideration of the restriction requirement is requested.

Statement of Facts

The above identified application includes three principal embodiments to which the claims are directed. The claims break down as follows according to these embodiments:

All of Figures 1 through 4, 7 and 8: claims 27, 28 and 32 through 34 (generic).

Figures 1 and 2: claim 29

Figures 3 and 4: claim 30

Figures 7 and 8: claims 31 and 35 through 50

In the Restriction Requirement, the claims are divided into "Species", claims 27 through 34 and claims 35 through 50. There is no recognition of the generic claims.

Discussion

The Restriction Requirement which is the subject of this Response divides the claims into two groups on the basis that each group represents a different species. There are three embodiments relevant to the claims disclosed in the application. All of claims 27, 28 and 32-34 are generic to all three species.

Long established policy and practice in the Patent Office is violated by restriction based on species where claims are generic to all embodiments. Reference is made to M.P.E.P. §806.04(e) in relevant part:

Claims Restricted to Species:

Claims are definitions of inventions. *Claims are never species.* Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).

Species are always the specifically different embodiments.

The emphasis in the quotation, directly on point here, is original with the MPEP.

In the Official Action, the Restriction Requirement was justified by a recitation of that to which each group of claims is directed: "Claims 27-34 direct to cell phone holding and charging device comprising...." "Claims 35-50 direct to cell phone holding and charging device comprising" M.P.E.P. §806.04(e) is clear. It is not claims that make multiple species, but embodiments.

Again, claims 27, 28 and 32-34 are generic to all three species. Reference is made to M.P.E.P. §806.04(d) in relevant part:

a. Definition of a Generic Claim

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

These generic claims do not have limitations excluding any of the embodiments of Figures 1 and 2, 3 and 4 and 7 and 8. They satisfy the test of M.P.E.P. §806.04(d). This may be viewed from the standpoint of section M.P.E.P. §806.04(f) as well:

a. Claims Restricted to Species, by Mutually Exclusive Characteristics

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

Claims 27, 28 and 32-34 meet this criteria. Further generic claims allow inclusion of species claims as established in M.P.E.P. §806.04(d) in relevant part:

a. Definition of a Generic Claim

Once a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof. When all or some of the claims directed to one of the species in addition to the elected species do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species..

To advance the application based upon an appropriate restriction, applicant elects the species of Figures 7 and 8. This election includes generic claims 27, 28 and 32-34 as well as species claims 31 and 35-50. Claims 29 and 30 would then be appropriately held until allowance of a generic claim.

Applicant does not take a position regarding distinctness of the claims.

Conclusion

The Restriction Requirement divides claims into groups of "species" in contravention of M.P.E.P. §806.04. The three different embodiments are reflected in certain generic claims as noted above which tie all three embodiments together. However, the generic claims are ignored. The Restriction Requirement based on a categorization of claims as species is in error and voids the very provisions for allowable species with a generic claim and multiple independent claims bought and paid for. Reconsideration of the Restriction Requirement is requested.

Respectfully submitted,

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